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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,676	02/24/2004	Thomas J. Foster	H10313/JDP	8393

1333 7590 08/09/2006

PATENT LEGAL STAFF  
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EXAMINER

SCHLACK, SCOTT A

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/785,676	<b>Applicant(s)</b> FOSTER, THOMAS J.	
	<b>Examiner</b> Scott A. Schlack	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/22/05</u> . | 6) <input type="checkbox"/> Other: _____  |

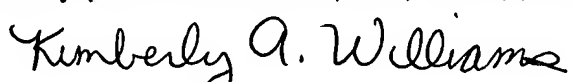
### DETAILED ACTION

1. In view of the appeal brief filed on 05/15/2006, PROSECUTION IS HEREBY REOPENED. Multiple Double Patenting issues as well as a Response to Arguments section are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below. 

### **Double Patenting**

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

***Regarding Double Patenting in view of Application: 10/812,686***

3. Claims **1-24** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1-12** and **14-25** of copending Application No. 10/812,686. Although the conflicting claims are not identical, they are not patentably distinct from each other. Below is a listing of the claim equivalencies (from the current application 10/785,676 to copending application 10/812,686) with minor obvious variations disclosed.

<b>Claim 1:</b> Claim 1 of copending app	<b>Claim 14:</b> Claim 16 of copending app
<b>Claim 2:</b> Claim 2 of copending app	<b>Claim 15:</b> Claim 17 of copending app
<b>Claim 3:</b> Claim 3 of copending app	<b>Claim 16:</b> Claim 18 of copending app
<b>Claim 4:</b> Claim 4 of copending app	<b>Claim 17:</b> Claim 19 of copending app
<b>Claim 5:</b> Claim 5 of copending app	<b>Claim 18:</b> Claim 20 of copending app
<b>Claim 6:</b> Claim 6 of copending app	<b>Claim 19:</b> Claim 21 of copending app
<b>Claim 7:</b> Claim 7 of copending app	<b>Claim 20:</b> Claim 23 of copending app
<b>Claim 8:</b> Claim 8 of copending app	<b>Claim 21:</b> Claim 24 of copending app
<b>Claim 9:</b> Claim 9 of copending app	<b>Claim 22:</b> Claim 25 of copending app
<b>Claim 10:</b> Claim 10 of copending app	<b>Claim 23:</b> Claim 26 of copending app
<b>Claim 11:</b> Claim 11 of copending app	<b>Claim 24:</b> Claim 27 of copending app
<b>Claim 12:</b> Claim 12 of copending app	<b>Claim 25:</b> Claim 28 of copending app

4. The examiner notes that in claims 1 and 7 of the copending application 10/812,686, the identifying step from equivalent claims 1 and 7 of the application 10/785,676 (the step wherein the enclosed edge pixels are identified) are not disclosed. However, the examiner notes that in both claim 1 and 7, the reassigning of a digital value to the edge pixels infers that the edge pixels have already been identified. This is necessarily inherent in order to facilitate the step of reassignment. The examiner views this and other minor inconsistencies to be obvious variations of the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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***Regarding Double Patenting in view of Application: 10/812,463***

5. Claims **1-24** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1-6, 8-13,16-21, 23-28** of copending Application No. 10/812,463. Although the conflicting claims are not identical, they are not patentably distinct from each other. Below is a listing of the claim equivalencies (from the current application 10/785,676 to copending application 10/812,463) with minor obvious variations disclosed.

<b>Claim 1:</b> Claim 1 of copending app	<b>Claim 13:</b> Claim 16 of copending app
<b>Claim 2:</b> Claim 2 of copending app	<b>Claim 14:</b> Claim 17 of copending app
<b>Claim 3:</b> Claim 3 of copending app	<b>Claim 15:</b> Claim 18 of copending app
<b>Claim 4:</b> Claim 4 of copending app	<b>Claim 16:</b> Claim 19 of copending app
<b>Claim 5:</b> Claim 5 of copending app	<b>Claim 17:</b> Claim 20 of copending app
<b>Claim 6:</b> Claim 6 of copending app	<b>Claim 18:</b> Claim 21 of copending app
<b>Claim 7:</b> Claim 8 of copending app	<b>Claim 19:</b> Claim 23 of copending app
<b>Claim 8:</b> Claim 9 of copending app	<b>Claim 20:</b> Claim 24 of copending app
<b>Claim 9:</b> Claim 10 of copending app	<b>Claim 21:</b> Claim 25 of copending app
<b>Claim 10:</b> Claim 11 of copending app	<b>Claim 22:</b> Claim 26 of copending app
<b>Claim 11:</b> Claim 12 of copending app	<b>Claim 23:</b> Claim 27 of copending app
<b>Claim 12:</b> Claim 13 of copending app	<b>Claim 24:</b> Claim 28 of copending app

6. The examiner notes that in claims **1** and **8** of the copending application 10/812,463, the identifying step from equivalent claims **1** and **7** of the application

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10/785,676 (the step wherein the enclosed edge pixels are identified) are not disclosed. However, the examiner notes that in both claim **1** and **8**, the reassigning of a digital value to the edge pixels infers that the edge pixels have already been identified. This is necessarily inherent in order to facilitate the step of reassignment. The examiner views this and other minor inconsistencies to be obvious variations of the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Regarding Double Patenting in view of Application: 10/812,605***

7. Claims **1-24** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 3-7, 9, 11-15, 19, 21-25, 27** and **29-33** of copending Application No. 10/812,605. Although the conflicting claims are not identical, they are not patentably distinct from each other. Below is a listing of the claim equivalencies (from the current application 10/785,676 to copending application 10/812,605) with minor obvious variations disclosed.

<b>Claim 1:</b> Claim 1 of copending app	<b>Claim 13:</b> Claim 19 of copending app
<b>Claim 2:</b> Claim 3 of copending app	<b>Claim 14:</b> Claim 21 of copending app
<b>Claim 3:</b> Claim 4 of copending app	<b>Claim 15:</b> Claim 22 of copending app
<b>Claim 4:</b> Claim 5 of copending app	<b>Claim 16:</b> Claim 23 of copending app
<b>Claim 5:</b> Claim 6 of copending app	<b>Claim 17:</b> Claim 24 of copending app
<b>Claim 6:</b> Claim 7 of copending app	<b>Claim 18:</b> Claim 25 of copending app
<b>Claim 7:</b> Claim 9 of copending app	<b>Claim 19:</b> Claim 27 of copending app
<b>Claim 8:</b> Claim 11 of copending app	<b>Claim 20:</b> Claim 29 of copending app

<b>Claim 9:</b> Claim 12 of copending app	<b>Claim 21:</b> Claim 30 of copending app
<b>Claim 10:</b> Claim 13 of copending app	<b>Claim 22:</b> Claim 31 of copending app
<b>Claim 11:</b> Claim 14 of copending app	<b>Claim 23:</b> Claim 32 of copending app
<b>Claim 12:</b> Claim 15 of copending app	<b>Claim 24:</b> Claim 33 of copending app

8. The examiner notes that in claims **1** and **9** of the copending application 10/812,605, the identifying step from equivalent claims **1** and **7** of the application 10/785,676 (the step wherein the enclosed edge pixels are identified) are not disclosed. However, the examiner notes that in both claim **1** and **9**, the reassigning of a digital value to the edge pixels infers that the edge pixels have already been identified. This is necessarily inherent in order to facilitate the step of reassignment. Also, the examiner notes the result of the method (thereby altering the appearance of the image when printed in order to compensate for printer nonuniformities) does not change the scope of the claimed invention in comparison to the 10/785,676 application. The examiner views this and other minor inconsistencies to be obvious variations of the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Regarding Double Patenting in view of Application: 10/812,517***

9. Claims **1-24** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1-6, 8-13, 16-21** and **23-28** of copending Application No. 10/812,517. Although the conflicting claims are not identical, they are not patentably distinct from each other. Below is a listing of the



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claim equivalencies (from the current application 10/785,676 to copending application 10/812,517) with minor obvious variations disclosed.

<b>Claim 1:</b> Claim 1 of copending app	<b>Claim 13:</b> Claim 16 of copending app
<b>Claim 2:</b> Claim 2 of copending app	<b>Claim 14:</b> Claim 17 of copending app
<b>Claim 3:</b> Claim 3 of copending app	<b>Claim 15:</b> Claim 18 of copending app
<b>Claim 4:</b> Claim 4 of copending app	<b>Claim 16:</b> Claim 19 of copending app
<b>Claim 5:</b> Claim 5 of copending app	<b>Claim 17:</b> Claim 20 of copending app
<b>Claim 6:</b> Claim 6 of copending app	<b>Claim 18:</b> Claim 21 of copending app
<b>Claim 7:</b> Claim 8 of copending app	<b>Claim 19:</b> Claim 23 of copending app
<b>Claim 8:</b> Claim 9 of copending app	<b>Claim 20:</b> Claim 24 of copending app
<b>Claim 9:</b> Claim 10 of copending app	<b>Claim 21:</b> Claim 25 of copending app
<b>Claim 10:</b> Claim 11 of copending app	<b>Claim 22:</b> Claim 26 of copending app
<b>Claim 11:</b> Claim 12 of copending app	<b>Claim 23:</b> Claim 27 of copending app
<b>Claim 12:</b> Claim 13 of copending app	<b>Claim 24:</b> Claim 28 of copending app

10. The examiner notes that in claims 1 and 9 of the copending application 10/812,517, the identifying step from equivalent claims 1 and 7 of the application 10/785,676 (the step wherein the enclosed edge pixels are identified) are not disclosed. However, the examiner notes that in both claim 1 and 9, the reassigning of a digital value to the edge pixels infers that the edge pixels have already been identified. This is necessarily inherent in order to facilitate the step of reassignment. Also, the examiner notes the result of the method (thereby altering the concentration of magnetizable

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substances within the image when printed in order to improve the readability of printed characters by reading instrumentation) does not change the scope of the claimed invention in comparison to the 10/785,676 application. The examiner views this and other minor inconsistencies to be obvious variations of the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

11. Applicant's arguments filed 05/15/2006 have been fully considered but they are viewed not to be persuasive.

12. Specifically, with regards to claim 1 (which is stated by the applicant as being "representative of all claims"), the applicant asserts that the Flickner et al. reference lacks the claimed features of "identifying enclosed edge pixels located on the edge of enclosed areas of print characters having enclosed areas, and, reassigning the digital value of one or more enclosed edge pixels independently of other pixels". The applicant also cites that the American Heritage Dictionary's (AHD) definition of the word "character", to support their assertion that Flickner does not disclose a print character. The AHD definition, as cited by the applicant, is as follows: character = "a mark or symbol used in a writing system".

***Examiner's Response:*** The examiner views that the Flickner et al. reference to encompass all of the claimed subject matter (col 3, lines 25-32, 55-68 and col 4, lines 1-34), and further notes that the circular ring image object (12 of Fig 1) qualifies as a print character according to the applicant's supplied reference.

Specifically, the examiner notes Flickner discloses the respective image object pixels as being identified (through an image scan) as image pixels ( $I_2$  of Fig 1), image hole pixels ( $H_2$  of Fig 1), or background pixels ( $H_0$  of Fig 1). The examiner views the Image pixels of the circular ring (12 of Fig 1) surrounding the hole to be equivalent to the claimed "enclosed edge pixels located on the edge of enclosed areas of print characters", and further views this ring to be equivalent to a "print character", as it is analogous in shape or appearance to a circular mark, letter, or symbol (i.e. the letter "O"). It can therefore be readily inferred that the referenced procedures set forth for identifying and reassigning values to the image pixels of and surrounding the "circular ring", would also function identically for any number of other characters similar in shape or appearance (col 3, lines 25-32, 55-68 and col 4, lines 1-34 and Fig 1).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A. Schlack whose telephone number is (571)272-7954. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

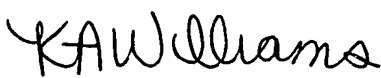
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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Scott A. Schlack

SPE Signature:

  
**KIMBERLY WILLIAMS**  
**SUPERVISORY PATENT EXAMINER**